

REMARKS

This responds to the Office Action mailed on April 7, 2005.

Claims 3 and 10 are amended. Claims 3-14 are now pending in this application.

Examiner Interview

Applicant acknowledges the telephone interview held on June 6, 2005, between the Examiner and Applicant's attorney during which amended claims 3 and 10 and the cited references were discussed. It was agreed that the amended claims would overcome the present rejection, but the Examiner said another search would probably be required in view of the amendments.

§103 Rejection of the Claims

Claims 3 and 7-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hunter et al. (US 6,071,030) in view of Policht (US 5,040,216).

Claims 3 and 7-9

Applicant has amended claim 3 to better describe the subject matter recited in the claim. Applicant believes claim 3 is not obvious in view of the cited references since there is no suggestion in the art to combine the references as suggested. Moreover, even if combined, the combination does not include each limitation recited in the amended claim.

Amended claim 3 recites: providing a blank photo-grade sheet; attaching a mounting strip along an edge of the blank photo-grade sheet; sending the blank photo-grade sheet and attached mounting strip through a printer to print a photographic image on the photo-grade sheet; and mounting the printed sheet in an album using the mounting strip.

Neither cited reference includes a blank photo-grade sheet. In contrast, Hunter discusses index dividers and Policht discusses mounting pre-developed photographic prints to a binder. Accordingly, even if combined, the combination does not include a blank photo-grade sheet or sending the blank photo-grade sheet and its attached mounting strip through a printer.

Moreover, the Hunter reference teaches away from applicant's claimed invention.

A factor cutting against a finding of motivation to combine or modify the prior art is when the prior art teaches away from the claimed combination. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path the applicant took. *In re Gurley*, 27 F.3d 551, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994).

Here, Hunter describes index divider sheets that are used for three-ring notebooks. One skilled in the art would not be motivated to substitute photo-grade paper for such divider sheets. Photo-grade paper would not work well as divider sheets, which require a heavy, stiff paper, such as cardstock. (Hunter, col. 6, lines 61-62). Accordingly, one skilled in the art, upon reading the Hunter reference would be led in a direction divergent from the subject matter recited in the claims since substituting photo-grade sheets for the cardstock of the Hunter index dividers is not a logically motivated substitution.

Claims 7-9 include each limitation of their parent claim and are therefore also not obvious in view of the cited references. Reconsideration and allowance is respectfully requested.

Claims 10-12

Applicant has amended claim 10 to better describe the subject matter recited in the claim. Applicant believes claim 10 is not obvious in view of the cited references since there is no suggestion in the art to combine the references as suggested. Moreover, even if combined, the combination does not include each limitation recited in the claim.

Claim 10 recites: providing a blank photo-printable photo-grade sheet having a hinge strip mounted along an edge of the photo-grade sheet, and sending the blank photo-printable photo-grade sheet with the hinge strip through a desktop printer to print a photographic image upon the photo-grade sheet. Again, as discussed above, neither reference discusses a blank photo-printable photo-grade sheet or printing a photographic image upon the photo-grade sheet. Hunter discusses cardstock index dividers and Policht discusses developed photo prints. Accordingly, even if combined, the combination does not include printing a photographic image upon a blank photo-printable sheet having a hinge strip mounted thereto.

Moreover, the cited references teach away from applicant's claimed invention. Again, Hunter describes index dividers that are made from cardstock. One skilled in the art would not be motivated to substitute developed photo-grade sheets for the cardstock of such index dividers.

Claims 11-12 include each limitation of their parent claim and are therefore also not obvious in view of the cited references. Reconsideration and allowance is respectfully requested.

Claims 4, 6, 13 and 14 were rejected under 35 USC § 103(a) as being unpatentable over Hunter et al. (US 6,071,030) in view of Policht (US 5,040,216) as applied to claims 3 and 7-12 above, and further in view of Tyler (US 4,207,366).

Claims 4, 6, and 13-14 include each limitation of their parent claims and are not obvious for the reasons given above. Moreover, Applicant traverses the present rejection. Applicant believes claims 4, 6 and 13-14 are not obvious in view of the present references since there is no suggestion to combine the references as suggested.

As noted, Hunter teaches an index divider. The secondary reference, Tyler, discusses an art paper used for watercolors. This teaches away from being used in a printer. Moreover, any combination of the Tyler paper substituted for the Hunter cardstock would not work well as an index divider since these are different papers for completely different uses.

Moreover, regarding claim 14, Applicant does not believe that the merely noting that Tyler teaches acid free paper is enough to find a motivation for one to provide an acid free hinge. One does not necessary lead to the other without a motivation in the art. Reconsideration and allowance is respectfully requested.

Claim 5 was rejected under 35 USC § 103(a) as being unpatentable over Hunter et al. (US 6,071,030) in view of Policht (US 5,040,216) as applied to claims 3 and 7-12 above, and further in view of Singh et al. (US 6,332,953).

Claim 5 includes each limitation of its parent claim and is not obvious for the reasons given above. Moreover, Applicant traverses the present rejection. Applicant believes claim 5 is not obvious in view of the present references since there is no suggestion to combine the references as suggested. As noted, Hunter teaches a cardstock index divider. The secondary reference, Singh, discusses an envelope paper. A combination of the Singh paper would not

work well as an index divider and thus the references teach away from being combined.
Reconsideration and allowance is respectfully requested.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 359-3267 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop RCE, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 27 day of June, 2005.

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